

REMARKS

This is in response to the Office Action mailed on May 29, 2008. In the Office Action, claims 1-21 were rejected under 35 U.S.C. §103(a). Reconsideration of the rejections is respectfully requested in view of the following remarks.

Claims 1-21 are pending in the patent application. Claims 1, 13, 14, 17, 20 and 21 have been amended. Support for Applicant's amendments is found in at least paragraphs [1018], [1027], [1038] and [1039] of Applicant's as-filed specification. No new matter has been added.

D) CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

In the Office Action, claims 1-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. US 2003/0231605 to Amerga ("Amerga") in view of U.S. Patent No. 6,810,019B2 issued to Steudle ("Steudle").

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-21 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claims 1, 13, 14, 17, 20 and 21 and claims 2-12, 15, 16, 18 and 19 variously depending therefrom, Applicant has amended independent claims 1, 13, 14, 17, 20 and 21 to include claims limitations not taught or suggested in the cited references. Specifically, Applicant's amended independent claims 1, 13, 14, 17, 20 and 21 each recite, in part, "scheduling a search based

at least in part on a serving cell transceiving gap defined for searching outside of a serving cell” and “[frequency switch blocking signal/suppressing frequency switches during the scheduled search] to override opening the serving cell transceiving gap for searching outside of the serving cell” which are not taught or suggested in Amerga or Steudle, either individually or in any proper combination.

In contrast, the Office Action, in the Response to Arguments section, improperly reads Steudle’s “gap” as teaching or suggesting Applicant’s “frequency switch blocking signal”. (Office Action, p. 2). The Office Action continues by stating, “If the Applicant intends to differentiate between the frequency switch blocking signal of the instant application and the transmission gaps of the reference, then such differences should be made explicit in the claims.” (Office Action. p. 4). Therefore, Applicant has amended independent claims 1, 13, 14, 17, 20 and 21 to explicitly recite, in part, “[frequency switch blocking signal/suppressing frequency switches during the scheduled search] to override opening the serving cell transceiving gap for searching outside of the serving cell”. Accordingly, Applicant’s “frequency switch blocking signal” as presently claimed functions to “suppress[]” or “override” “opening the serving cell transceiving gap for searching” and therefore Steudle’s “gap”, as previously interpreted, cannot teach a “frequency switch blocking signal” as previously alleged in the Office Action.

Therefore, since neither Amerga nor Steudle teach or suggest Applicant’s claimed invention including “scheduling a search based at least in part on a serving cell transceiving gap defined for searching outside of a serving cell” and “[frequency switch blocking signal/suppressing frequency switches during the scheduled search] to override opening the serving cell transceiving gap for searching outside of the serving cell”, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in amended independent claims 1, 13, 14, 17, 20 and 21. Accordingly, Applicant respectfully requests the rejection of presently amended independent claims 1, 13, 14, 17, 20 and 21 be withdrawn.

The nonobviousness of amended independent claim 1 precludes a rejection of claims 2-12 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claim 1 and claims 2-12 which depend therefrom.

The nonobviousness of amended independent claim 14 precludes a rejection of claims 15 and 16 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP

§ 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claim 14 and claims 15 and 16 which depend therefrom.

The nonobviousness of amended independent claim 17 precludes a rejection of claims 18 and 19 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claim 17 and claims 18 and 19 which depend therefrom.

CONCLUSION

In light of the amendments contained herein, Applicant submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: August 27, 2008

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